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| In re Application of | : | |
| IYER et al. | : | |
| Application No.: 09/581,122 | : | DECISION ON PETITION |
| PCT No.: PCT/US98/12394 | : | UNDER 37 CFR 1.47(a) |
| Int. Filing: 15 June 1998 | : | |
| Priority Date: 17 June 1997 | : | |
| Attorney Docket No.: 98-503-W0 | : | |
| For: FETAL OXIMETRY SYSTEM AND SENSOR | : | |

This is a decision on applicants' "Petition Under 37 CFR 1.47(a)" filed 11 June 2001 to accept the application without the signatures of joint inventors, Robert M. Johnson, Johannes Buschmann, Reinhold Falkowski, Steven R. Smith, Nick Tu, and Clifford Montagnoli. The required petition fee of \$130.00 (37 CFR 1.17(i)) has been submitted.

BACKGROUND

On 15 June 1998, applicants filed international application PCT/US98/12394, which designated the United States. A Demand for international preliminary examination electing the United States was filed prior to the expiration of 19 months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 17 December 1999.

On 20 December 1999, applicant filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a petition to revive under 37 CFR 1.137(b). The petition to revive was granted in a decision dated 16 August 2000.

On 12 February 2001, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a one-month time limit in which to respond.

On 11 June 2001, applicant filed the present petition and a petition for a four-month extension of time.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or

declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Items (1), (3) and (4) have been satisfied.

Regarding item (2) above, Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Such a petition will be dismissed as inappropriate.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

a. Inventor Robert M. Johnson

A review of the present petition reveals that applicants have not provided an acceptable showing that a diligent effort was made to reach the non-signing inventor, Robert M. Johnson. The declaration of Cheryl L. Gastineau alleges that inventor Robert M. Johnson cannot be found or located. Additionally, the declaration states, "[o]n March 29, 2001, I sent Robert M. Johnson a letter via first class mail . . . the letter was "Returned to sender undeliverable as addressed unable to forward." However, no documentary evidence to support the failed attempts was provided in Cheryl L. Gastineau's declaration. Copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

b. Inventor Johannes Buschmann

A review of the present petition reveal that applicants have not provided an acceptable showing that a diligent effort was made to reach the non-signing inventor, Johannes Buschmann. The declaration of Cheryl L. Gastineau alleges that inventor Johannes Buschmann cannot be found or located. However, no documentary evidence to support the failed attempts was provided in Cheryl L. Gastineau declaration.

In order to meet the requirements of 37 CFR 1.47(a) and Section 409.03(d) of the MPEP, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of

the application papers was sent to Johannes Buschmann, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

c. Inventor Reinhold Falkowski

A review of the present petition reveal that applicants have not provided an acceptable showing that a diligent effort was made to reach the non-signing inventor, Reinhold Falkowski. The declaration of Cheryl L. Gastineau alleges that inventor Reinhold Falkowski cannot be found or located. However, no documentary evidence to support the failed attempts was provided in Cheryl L. Gastineau declaration.

In order to meet the requirements of 37 CFR 1.47(a) and Section 409.03(d) of the MPEP, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers was sent to Reinhold Falkowski, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

d. Inventor Steven R. Smith

A review of the present petition reveal that applicants have not provided an acceptable showing that a diligent effort was made to reach the non-signing inventor, Steven R. Smith. The declaration of Cheryl L. Gastineau alleges that inventor Steven R. Smith cannot be found or located. Additionally, the declaration states, "[o]n March 29, 2001, I sent Steven R. Smith a letter via first class mail . . . the letter was "Returned to sender undeliverable as addressed unable to forward." However, no documentary evidence to support the failed attempts was provided in Cheryl L. Gastineau's declaration. Copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

e. Inventor Nick Tu

A review of the present petition reveal that applicants have not provided an acceptable showing that a diligent effort was made to reach the non-signing inventor, Nick Tu. The declaration of Cheryl L. Gastineau alleges that inventor Nick Tu cannot be found or located. Additionally, the declaration states, "I sent Nick Tu a letter dated January 18, 2001 . . . The envelope was returned to us unopened on January 29, 2001 and stamped with the message 'Return to Sender, No such number'." However, no documentary evidence to support the failed attempts was provided in Cheryl L. Gastineau's declaration. Copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

f. Inventor Clifford Montagnoli

A review of the present petition reveal that applicants have not provided an acceptable showing that a diligent effort was made to reach the non-signing inventor, Clifford Montagnoli. The declaration of Cheryl L. Gastineau alleges that inventor Clifford Montagnoli cannot be found or located. However, no documentary evidence to support the failed attempts was provided in Cheryl L. Gastineau declaration.

In order to meet the requirements of 37 CFR 1.47(a) and Section 409.03(d) of the MPEP, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy

of the application papers was sent to Clifford Montagnoli, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

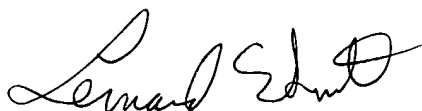
For the above reasons, it would not be appropriate to accept this application without the signature of Robert M. Johnson, Johannes Buschmann, Reinhold Falkowski, Steven R. Smith, Nick Tu, and Clifford Montagnoli at this time.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention to the PCT Legal Office.



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